

REMARKS

Claims 1-9 are pending and stand rejected.

Claims 1-8 stand rejected under 35 USC 101. Applicants respectfully traverse because computers, microprocessors, and special purpose devices incorporating computers are unquestionably statutory subject matter. Moreover, computer software is also statutory subject matter. The claimed invention is NOT a data structure. Applicant will briefly summarize the invention; however, the Examiner is respectfully referred to the detailed description of the invention for a full explanation of the invention. Moreover, Applicant respectfully invites the Examiner to telephone the undersigned to discuss any aspects of the invention which are unclear.

The claimed invention is a unique personal information manager (PIM). The Examiner is undoubtedly familiar with popular PIMs such offered by Research In Motion Corp (Blackberry®) and PALM Corp (TREO ®). The PIM of the claimed invention is an apparatus, and is not data, a data structure, nor functional descriptive material recorded. The claims recite the functional/structural components of the PIM, some of which may be implemented either as hardware or software. In any event none of the recited features are directed toward data structures *per se*; however, the invention does in fact utilize data structures (as do most if not all computers).

Claim 1 present recites a personal information manager, which as explained above is an apparatus. The PIM includes a data input *device* receiving an audio data stream, and decoding the data stream into text. See claim 1, line 2. The PIM further includes a dialog manager having two modes of operation; namely, a record mode and a dialog mode. Neither the data input device nor the dialog manager are data structures. The PIM further recites an information storage/retrieval module storing and retrieving

data from a database. Again, the information storage/retrieval module is not a data structure but, as recited, a special purpose programmed processor which stores and retrieves data.

For at least these reasons, Applicant respectfully requests that the rejection of claim 1-8 be reconsidered and withdrawn.

Claims 1, 2 and 6 stand rejected under 35 USC 103(a) as being unpatentable over Greene (US 6377925) in view of Dumais (US 20040267700). Applicant respectfully traverses as follows.

Greene discloses an electronic translator which decodes voice into text, displays the text and/or displays a sign language and possibly speaks the decoded word. Greene fails to disclose or suggest a dialog manager having a record mode and a dialog mode, where the dialog manager examines decoded text to determine whether it contains an explicit or an implicit data processing request, a feature of the rejected claims. Not only does Green fail to disclose the above-recited feature, but there is no motivation for one of ordinary skill in the art to modify a device according to Green to include the recited record mode because the primary object of Green is to provide real-time translation. The concept of recording a conversation is antithetical to the stated goal of a real-time translation device. In contrast, the main purpose of the present patent is the recording of spoken text for later retrieval. In this sense, it is more akin to a conventional diary; only that retrieval is done by voice and features a non-linear fashion of access to data.

Likewise, Greene fails to disclose or suggest the feature of the rejected claims where the dialog manager immediately passes explicit data processing requests and queues implicit data processing requests, another feature of the rejected claims. Again, Greene not only fails to disclose or suggest the recited feature regarding differential treatment of implicit and explicit data processing requests but such differentiation would not be useful in a real-time translator in which all requests are handled in real-time (on-the-fly).

Finally, Greene fails to disclose or suggest the feature where the dialog manager passes implicit processing requests to the information storage/retrieval module during periods of inactivity. Yet again, Greene not only fails to disclose or suggest the recited feature but there is absolutely no motivation to provide utility for processing (implicit) requests during periods of inactivity because doing so would defeat the real-time aspect of the real-time translator.

The rejection acknowledges some of the shortcomings of Greene but nevertheless plucks features from Dumais and grafts them onto Greene. While the undersigned is cognizant of the recent case law regarding obviousness, the reliance on hindsight is still impermissible. The instant rejection appears to impermissibly rely on Applicant's disclosure as a template in picking and choosing features from disparate sources in a manner which would not have been obvious at the time of the invention. To reach a

proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Dumais discloses a device which indexes and categorizes documents and web pages which have previously been accessed or considered. See paragraph [0021]. Importantly, Dumais operates on textual documents whereas the rejected claims recite a PIM which operates on an audio data stream. Furthermore, Dumais fails to disclose or suggest the feature of the invention wherein the decoded text is examined to determine whether it contains an explicit or an implicit data processing request. Dumais does *not* examine the *textual documents* to determine whether they contain implicit or explicit data processing requests. Instead, Dumais teaches that the *user interface* may include

explicit and implicit queries for retrieving data along with explicit and implicit tagging of items for ease of recall and retrieval. In other words, when the user initiates a browser search of the internet, the browser would include an implicit search of recently accessed (indexed) documents. An implicit request within a browser is a different concept from the feature of the claimed invention wherein the *information being decoded* may contain implicit/explicit data processing requests.

The combination of Greene and Dumais further fails to disclose the feature of claim 2, wherein the dialog manager identifies an explicit data processing request during the record mode by comparing the decoded text against a list of reserved words.

Contrary to the Examiner's assertion, the combination of Greene and Dumais fails to disclose or suggest the feature where the dialog manager examines decoded text to determine whether it matches any of the words in the global word table and wherein a request for clarification is queued if the decoded text does not match any word in the global word table. Dumais teaches a simple indexing scheme and does not include the recited verification or the recited clarification features of claim 6.

The rejection asserts that it would be obvious to one of ordinary skill in the art at the time of the invention to combine Greene's speech based communication with Dumais' [text based] explicit, implicit and standing queries, because this would allow to prioritize processes. Applicant does not understand the meaning of the phrase "prioritize processes

in the context of a real-time translator.” Why would one of ordinary skill in the art be motivated to prioritize processes in a real-time translator in which all translation processes are handled in real-time (the stated object of the invention)? Similarly, what motivation would one of ordinary skill in the art have to prioritize processes in indexing the text documents browsed by the user? None – because the system according to Dumais processes (indexes) documents in sequence as the user browses. As stated in the MPEP, “[t]he modification must be one which would have been *obvious* to one of ordinary skill in the art at the time the invention was made.” MPEP 706.02 (Emphasis added). How can a combination be “obvious” if the combination negates the essential purpose of the invention?

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that *the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit*. The Federal Circuit has stated that “*rejections on obviousness cannot be sustained with mere conclusory statements*; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

The present rejection fails to provide a clear articulation of the reasons why the claimed invention would have been obvious. Accordingly, the Examiner has not

demonstrated *prima facie* obviousness. For at least these reasons, Applicant respectfully requests that the rejection of claim 1, 2 and 6 be reconsidered and withdrawn.

Claims 3-5, and 7-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Greene in view of Dumais and in further view of Dunning US 7,162,482.

As a preliminary matter, Applicant respectfully traverses the rejection of claims 3-5 and 7-9 for the reasons articulated above in traversing the rejection of claims 1, 2 and 6.

Applicant further traverses the rejection as applied to claims 3 and 4 because the combination fails to disclose the feature wherein the dialog manager identifies an explicit data processing request during said *dialog mode* by comparing said *decoded text* against a list of predefined data processing requests, assigning a match score to each of said predefined data processing requests and selecting said predefined data processing request having a highest matching score as said explicit data processing request.

None of the cited references examine the decoded text to see whether it contains an implicit data processing request. Greene decodes audio into text and processes the text but never checks to see if it contains a request. Dumais indexes and stores text but never checks to see if it contains a request. Dunning too fails to decode audio into text and checks to see if it contains a request. Thus the combination fails to disclose or suggest features of claims 3 and 4.

Applicant further traverses the rejection as applied to Claims 7 and 8 because the asserted combination fails to disclose the recited features of the claims. The claims recite specific features whereas the rejection asserts broad principles which fail to disclose or render obvious the recited features.

For example, claim 7 recites that the information storage/retrieval module stores atoms of data, each said atom having a unique identifier; and that the local word table contains a list of words contained in each atom of data and the number of times each word appears in a given atom. The cited combination of references fails to disclose or suggest this feature of claim 7. Claim 7 further recites that if a number of atoms matching a data retrieval request exceeds a predetermined number, the dialog manager *prompts a user to select a given characteristic word from a list of characteristic words*, said characteristic words being derived from the local word tables of atoms matching said data retrieval request, said selected characteristic word being appended to a search string of the data retrieval request, thereby reducing the number of atoms matching a data retrieval request. Again, the cited combination of references fails to disclose or suggest this feature of claim 7.

Applicant has amended Claim 9 to correct a typographical error. No new matter is believed to be introduced by the amendment.

Applicant respectfully asserts that the rejection has not addressed any of the features of claim 9, and has not therefore presented a *prima facie* case of obviousness. Claim 9 recites features which are *not* recited in claims 1-8 and these features are not addressed in the rejection. Therefore, the Examiner still has the burden of establishing obviousness -- Applicant only has the duty to traverse once the Examiner has met his statutory burden of establishing *prima facie* obviousness.

For this additional reason, Applicant traverses the rejection of claim 9.

Should the claims herein be allowable but for minor matters that could be the subject of either a further submission by Applicants or an Examiner's Amendment, Applicants would appreciate the Examiner's contacting Applicants' undersigned attorney.

Reconsideration and allowance of all the claims herein are respectfully requested.

Respectfully Submitted,

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